

REMARKS/ARGUMENTS

Claims 93 to 108 and 110 to 146 are pending in this application and are subject to restriction under 35 U.S.C. § 121, as follows:

| Group | Claims | Class/Subclass | Subject Matter |
|-------|---|----------------|---|
| I | Claims 93 to 108 and 110 to 146 (in part) | 546/1+ | Directed to compositions and methods having Formula VII where the Het is pyridinone (A) |
| II | Claims 93 to 108, 110 to 116, 119 to 132, and 146 (in part) | 544/239 | Directed to compositions and methods having Formula VII where the Het is 3H-pyrimidin-4-one (B) |
| III | Claims 93 to 108, 119 to 132, and 146 (in part) | 544/240 | Directed to compositions and methods having Formula VII where the Het is 1H-pyrimidine-2,4-dione (C) |

It is asserted that the inventions of Groups I to III are distinct, each from the other because they are unrelated due to their structural differences among the heterocyclic groups present in the structures. In addition, a requirement has also been made for an election of species.

According to MPEP § 803, there are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 to § 806.05(i)); and
- (B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) to § 806.04(i), § 808.01(a), and § 808.02).

For purposes of the initial requirement, a serious burden may be *prima facie* shown if the examiner shows separate classification, separate status in the art, or a different field of search as defined in MPEP § 808.02. Applicants respectfully submit that Groups II and III are similarly classified. Accordingly, applicants request reconsideration of the restriction as a whole and among Groups II and III since they are in the same class.

While applicant does not believe that a proper requirement for restriction has been established, applicant believes that any restriction among the members of the Markush groups of subgroups A to C of Het within the claims should only be made *provisionally*. MPEP § 803.02, which addresses restriction practice with respect to Markush-type claims, clearly sets forth that the Examiner may only require a *provisional* election of a single species prior to examination on the merits. The provisional election would be given effect in the event that the Markush-type claim was found not to be allowable. Following election, the Markush-type claim would be examined fully with respect to the elected species and further to the extent necessary to determine patentability. If the Markush-type claim were not allowable over the prior art, examination would be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration. However, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim would then be extended.

The MPEP provides an example in the case of an application with a Markush-type claim drawn to the compound C-R, wherein R is a radical selected from the group consisting of A, B, C, D, and E. With such a claim, the examiner may require a *provisional* election of a single species (CA, CB, CC, CD, or CE). The Markush-type claim is then examined fully with respect to the elected species and any species considered to be clearly unpatentable over the elected species. If, on examination, the elected species is found to be anticipated or rendered obvious by prior art, the Markush-type claim and claims to the elected species would be rejected, and claims to the non-elected species would be held withdrawn from further consideration. On the other hand, if no prior art anticipates or renders obvious the elected species, the search of the Markush-type claim would then be extended.

Thus, applicants respectfully request reconsideration of the requirement for restriction, and in particular an indication that the requirement among Groups I to III (for Het of A, B, or C) is only a provisional election for the purpose of carrying out the search.

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Nonetheless, to be fully responsive to the restriction requirement, applicant elects *with traverse* to prosecute the claims of **Group I (claims 93 to 108 and 110 to 146)**. Further, applicants elect

3-(3-methylphenylsulfonyl)amino-6-methyl-1[(2-guanidinooxyethyl)aminocarbonylmethyl]-2-pyridinone (Example 5).

In Formula VII, R^1 is 3-methyl phenyl (substituted aryl)

Z is $-SO_2-$

Het is A

R^3, R^4 are hydrogen

R^5 is methyl (alkyl)

R^7 is hydrogen

R^8 is hydrogen

$R^{12}, R^{13}, R^{14}, R^{15}$ are hydrogen

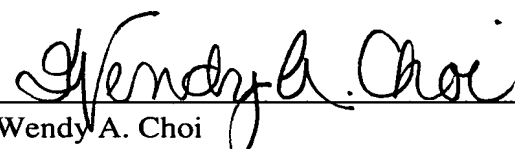
X is oxygen

R^a, R^b, R^c are hydrogen.

This species reads on claims 93 to 108 and 110 to 121, 125 to 142, 144 to 146.

If the Examiner wishes to discuss the restriction requirement, the Examiner is requested to contact the undersigned attorney at (215) 557-3861.

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